

## **REMARKS**

### **Claim Status**

Applicants thank Examiner Perungavoor Venkatanaray and Examiner Gilberto Barron, for their courtesies extended during the Telephonic Interview conducted on October 10, 2006, and for their assistance in furthering prosecution on the merits of the present application. During the Telephonic Interview, the Examiners agreed that the pending claims are patentable over the prior art of record. The following remarks expand on the substance of the interview.

Claims 1-4 are currently pending, with claim 1 being in independent form. No new matter has been added. Reconsideration of the application is respectfully requested.

### **Overview of the Office Action**

Claims 1-4 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2001/0054010 ("*Bernabeo*").

The Examiner (pg 3. item 3 of the Office Action) has referred to Applicants' arguments with respect to dependent claim 5. However, only claims 1-4 are pending in the Office Action. Clarification of this issue is requested.

Applicants have carefully considered the Examiner's rejection, and the comments provided in support thereof, and respectfully disagree with the Examiner's analysis. For the reasons which follow, it is respectfully submitted that all claims of the present application are patentable over the applied reference.

### **Patentability of the independent claim over the prior art**

Independent claim 1 positively recites that "the appropriate device code is required to operate the device, at least for the first commissioning of the device". Claim 1 further recites the

step of “rendering the device to be inoperable until it receives the appropriate device code”.

*Bernabeo* fails to teach or suggest these limitations.

The Examiner contends (pg. 2, item 2 of the Office Action) that:

Bernabeo ... discloses ... the device not operable without the device service code see Par. 0028 as Bernabeo mentions the device given to the purchaser or else the device is idle and not operable. It is suggestive that when the device is given to the purchaser so that he/she may use it(operable), but as it sits inventory it is unlikely to be in operable state because such would be waste of resources(power, battery). And further, Bernabeo discloses the operability being reliant on the redemption code received from the purchaser, thus effectively controlling the usability of the device. And finally, the operability/controllability of the device is further illustrated with the movie theater admittance being reliant on the redemption code see Par. 0030.

However, *Bernabeo* fails to disclose the invention recited in independent claim 1. The ability of the claimed device to be operated is device specific, as opposed to the organizational measures associated with the check that is performed in *Bernabeo*. In particular, *Bernabeo* (paragraph [0028]; Fig. 4) teaches a method associated with ensuring that a device is delivered to a client (i.e., a purchaser) only if a previous payment for the device is made. *Bernabeo* (paragraph [0028], lines 9-12) teaches that an electronic redemption code is transmitted to the purchaser for this purpose (step 48), and that the electronic redemption code is received via a receiving device (step 50). However, this receiving device is not the purchased product.

*Bernabeo* (paragraph [0028], lines 17-20) teaches that the purchaser is provided with a product (step 54) if the electronic redemption code corresponds to an electronic sales code. It is possible to perform such a step in a retail store. However, the redemption taught in *Bernabeo* has nothing to do with the ability of the purchased product to be operated. For example, the person who delivers the product to the purchaser can use (i.e., operate) the product himself without even possessing the electronic redemption code. Moreover, the electronic redemption

code of *Bernabeo* provides the person who delivered the product with the possibility to perform a check of a database to determine whether a previous payment for the product has been made. However, it is irrelevant whether the product is a computer, a food product or a service. Consequently, *Bernabeo* discloses a method in which the properties of the product have nothing to do with the method. Clearly, *Bernabeo* teaches that the ability of a person to use the product is independent from the redemption code.

*Bernabeo* (paragraph [0014], lines 8-11) states that “if the electronic redemption code is received at the electronic redemption device and corresponds to an electronic sales code marked as valid, the vendor will supply the purchaser with the purchased product”. *Bernabeo* thus clearly teaches that the only function of the redemption code is to allow a database to be checked to determine whether payment for the product has been received, and after obtaining this information the vendor will supply the purchaser with the purchased product.

In contrast, the device of present claim 1 cannot be operated without providing the individual device code to the device at least once. There is nothing in *Bernabeo* to even hint at rendering the device inoperable until it receives the appropriate device code. In view of the foregoing, Applicants respectfully assert that *Bernabeo* fails to anticipate claim 1. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 are in order.

Moreover, due to the fundamental above-discussed differences between the present claimed invention and *Bernabeo*, it is clear that the present invention is patentable over this reference under 35 U.S.C. §103.

#### **Dependent Claims**

In view of the patentability of independent claim 1, for the reasons set forth above, each of dependent claims 2-4 is patentable therewith. In addition, these claims include features which serve to even more clearly distinguish the present invention over the prior art.

For example, dependent claim 2 recites that “the appropriate device code is stored in the device.” *Bernabeo* (paragraph [0013]) teaches that the electronic redemption code is transmitted to an electronic storage device that is not the purchased product. Moreover, *Bernabeo* (paragraph [0036]) teaches that the electronic redemption code is stored on a Sony memory stick. However, the memory stick is not the purchased product.

### Conclusion

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Respectfully submitted,  
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Dated: October 16, 2006